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10/698,392

11/03/2003

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03/20/2006

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EXAMINER

GREENHUT, CHARLES N

ART UNIT

PAPER NUMBER

3652

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/698,392 | Applicant(s) HIRAGUCHI ET AL. | |
| | Examiner Charles N. Greenhut | Art Unit 3652 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/3/03</u> . | 6) <input type="checkbox"/> Other: ____ |

I. Claim Rejections - 35 USC § 112

The following is a quotation from the relevant paragraphs of 35 U.S.C. 112:

(2) The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1.1. With respect to claim 1, the preamble recites, "A structure for holding a recording tape cartridge...different types of recording tape cartridges each comprising:". This preamble renders the claim indefinite because it is ambiguous. It is unclear whether the elements delineated after the transitional phrase "comprising" are limitations on "A structure for holding a recording tape cartridge" or "recording tape cartridges." The claim appears to be directed to "A structure" however the transitional phrase is modified by the term "each" which implies a plurality, and therefore apparently refers to the cartridges.

1.2. With respect to claim 1, applicant attempts to define a property ("a height" and "an interval") of the claimed apparatus by reference to a step combined with an intended result ("made to be the same"). This language lacks the essential structural limitations, required in an apparatus claim, that clearly defines the scope of the subject matter for which applicant seeks protection. If applicant wishes to define his claim in terms of the desired results or function of the structure, without recital of the structure itself, applicant must do so in accordance with 35 U.S.C. 112, sixth paragraph.

1.3. While the specification discloses compatibility with the tape cartridges described at (108) and (118), it is unclear how the apparatus is compatible with any tape cartridge as implied by the language “regardless of a type of the recording tape cartridge.”

1.4. With respect to claim 8, the step of, “making a height...and an interval...the same” is indefinite because it could be interpreted to mean that the height and interval are dimensionally the same, while the equation ($H=J$, $L=K$, $W2=V$) on page 28 of the specification seems to indicate this is not the case.

II. Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim(s) 1-14 is/are rejected under 35 U.S.C. 102(b) as being anticipated by SMITH (US 6,141,180 A).

1.1. With respect to claims 1 and 8, SMITH discloses a case (106), grasped portion (116), concave portion and chamfer (Fig. 1).

1.2. With respect to claims 2, 3, 5, 9, 10 and 12 SMITH additionally discloses overhang portions and inclined walls at rear sides continuous from side walls (Fig. 4).

1.3. With respect to claims 4, 7, 11 and 14, SMITH additionally discloses the overhang portions are reference surfaces and the inclined walls are guide surfaces (Fig. 4).


1.4. With respect to claim 6 and 13, SMITH additionally discloses the claw portions inserted into the concave portions (Fig. 3).

Art Unit: 3652

III. Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Greenhut whose telephone number is (571) 272-1517. The examiner can normally be reached on 7:30am - 4:00pm EST.
3. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.
4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CG


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600